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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,867	07/28/2003	Henri Hannula	0365-0568P	3629
2292 7590 05/24/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
DOWE, KATHERINE MARIE				
ART UNIT		PAPER NUMBER		
3734				
NOTIFICATION DATE		DELIVERY MODE		
05/24/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/627,867

Applicant(s)

HANNULA ET AL.

Examiner

KATHERINE M. DOWE

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 10, 2010 has been entered.
2. Claims 26-49 are currently pending.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 26-32, 35-43, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferre et al. (US 6,694,167). Ferre et al. disclose a stereotactic device comprising a frame (102) configured to mount on the nasion of a subject extending frontally below the eyes to end positions of the frame that are in front of the face of the subject and outside a field of vision of the subject such that the frame is capable of contacting only the nose of the subject and located in front of a plane defined by the eyes of the subject without immobilizing the subject's head (Figs 1 and 18). All portions of the frame (102) are capable of being located below the eyes and a forehead of the subject. At least three fiducial markers (116) are mounted on the frame and configured

to define a position of the frame with respect to the subject, wherein at least three of the fiducial markers are in different vertical lines from one another, the vertical lines being perpendicular to the frame (Figure 18, col 8, ll 25-32). The frame includes a nasion relator portion comprising a nose piece (32) compliant with a contour of the subject's nose. A supporting element (30/34) is attached to the end positions of the frame to secure the device to the subject. Ferre et al. further discloses a diagnostic method comprising mounting the frame on the nasion of the subject, defining a position of the frame with respect to the subject via the three fiducial markers, and performing a diagnosis based on the defined position of the frame with respect to the subject (col 2, ll 19-37; col 8, ln 3 – col 9, ln 26).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 33, 34, 44, 45, 48, and 49 rejected under 35 U.S.C. 103(a) as being unpatentable over Ferre et al. (US 6,694,167), as applied to claims 32 and 43 above, in view of Anthony (US 6,758,218). Ferre et al. disclose the invention substantially as claimed as shown above including an adjustable supporting element (30/34) to secure the frame to the subject. However, Ferre et al. do not disclose the supporting element is an adjustable band that passes behind the subject's head, neck, or shoulders such that the supporting element forms a closed loop. Anthony discloses a similar device with a frame (500) configured to be mounted on a subject's face (Figure 9) and teaches

the frame is fixed on the subject with an adjustable band (510) that extends laterally from the frame and passes behind the subject's head (col 23, ll 22-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Ferre et al. such that the supporting element comprised an adjustable band that passes laterally from the frame (102) and behind the subject's head to more securely hold the frame in place on the subject's face. When the device of Ferre et al. is modified in this manner, the supporting element would also be configured to be located only between an eye level and a neck level of the subject when the frame is mounted on the nasion of the subject.

Response to Arguments

7. Applicant's arguments filed May 10, 2010 have been fully considered but they are not persuasive.
8. Applicant argues Ferre et al. discloses multiple distinct embodiments and it is not proper to combine features from two distinct alternative embodiments. The examiner acknowledges distinct features of alternative embodiments may not be inherently combined if not taught in the reference as a combination. However, when discussing the embodiment of Figures 18-19, Ferre et al. disclose, "For example, as shown in FIGS. 18 and 19 another embodiment of a headset 100 of the invention includes two ear mounts 28, side members 30, and a nose bridge mount 32 on center member 34 as *discussed above with reference to FIGS 2-4*" (col 8, ll 5-8; emphasis added).

9. Applicant argues it is not proper to select a single portion, such as center member 34 of the head set 12, to define the claimed frame of the present invention. The examiner respectfully disagrees. The center member 34 is clearly one element of the entire device comprising the frame, fiducial markers, nasion relator portion, and supporting element. The examiner notes if the center member cannot be considered a separate element, then by the same argument Applicant's "frame", "fiducial markers", "nasion relator portion", and "supporting element" cannot be considered separate elements making up the claimed stereotactic device.

10. Applicant argues the center member 34 may not be interpreted as the claimed "frame" because it extends downwardly from a point above the eyes at a center of the forehead and passes between the patient's eyes. The examiner respectfully notes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The frame defined by the center member 34 is capable of being mounted onto the nasion of a subject such that it extends frontally below the eyes of the subject to end positions of the frame that are in front of the face of the subject and outside a field of vision of the subject. However, to advance prosecution, the frame has been re-interpreted as the center plate 102 in Figures 18-19. The frame 102 is located on the end of the center member 34 adjacent the nasion relator portion 32 such that all portions of the frame are capable of being located below the eyes and a forehead of the subject.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571) 272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe
May 19, 2010

/K. M. D./
Examiner, Art Unit 3734

/TODD E. MANAHAN/
Supervisory Patent Examiner, Art Unit 3734